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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,979	12/22/2000	Manoel Tenorio	020431.0748	8474
53184	7590	01/13/2006	EXAMINER	
i2 TECHNOLOGIES US, INC. ONE i2 PLACE, 11701 LUNA ROAD DALLAS, TX 75234			WEISBERGER, RICHARD C	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,979

Applicant(s)

TENORIO, MANOEL

Examiner

Richard C Weisberger

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 06/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

CC

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The applicant asserts that the system of claim 1 should read on a collection of components. Given this reading, the claims are nonstatutory. For example claim 1 includes two components, 1) a database, and a 2) a pricing engine. Neither of these components are concrete or tangible. Each reads on software. To be concrete and tangible the database and pricing engines must be programmed on a computer processor. To be statutory claim 1 should be amended to include a computer processor.

Claim Rejections - 35 USC § 112

1. Claims 3, 12, 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection over substantially non-fungible is maintained. The applicant argues that a definition for the term is provided at page 7, line 19 through page 8, line 31. This argument is not persuasive. No express definition is found within this cited section.

Art Unit: 3624

Moreover, earlier in the specification the applicant states that [W]here considerations external to the actual identity of items make otherwise fungible items non-fungible, the considerations may be normalized to make such items essentially fungible as quasi-commodities.⁶ As an example, although sugar is inherently fungible as an item, two shipments of sugar delivered on different days and at different locations will generally not be treated identically in the marketplace. By normalizing according to the delivery date and location, however, the sugar may be made fungible since shipments of sugar delivered on the same day and at the same location will be treated identically in the marketplace." Clearly the lines of demarcation of goods classified as fungible/quasi-fungible/non-fungible are not claimed with sufficient particularity.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-3,5-8,10-12,14-17, 20-22 and 24-27 rejected under 35 U.S.C. 102(b) as being anticipated by Reuhl.

The applicant argues that the references fails to teach a system of pricing non-fungible items. The prior art teaches that the reference item can be the same or substantially similar. The examiner consistent with the guidance of the applicant's specification,

Art Unit: 3624

interprets a non-fungible item to be a substantially similar item. As to the applicant's general allegation that the prima facie case of anticipation fails to identify where in the single reference each and every facet of the claim 1 can be found, the rejection of 9/3/04 provide ample guidance. The examiner does agree with the applicant's legal definition of anticipation beginning on page 17, continuing on page 18, further continuing on page 19, and even further continuing on page 20, and even further continuing on page 21. Unfortunately, but for page 18, lines 5-7, and lines 24-28, the facts outlined don't appear to be relevant to the instant case.

The applicant's argument is not persuasive when applied to the software for executing the process. The code as claimed would be the same for fungible, non-fungible, or partially fungible items. The rejection is FINAL.

Claim Rejections - 35 USC § 103

5. Claims 4,13, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reuhl in view of Foley .

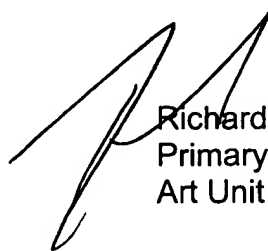
6. The rejection is of record. The applicant argues that there is no motivation for combining the two references. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

Art Unit: 3624

1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, price accuracy is a well known variable in the art of Reuhl. One skilled in the art would look to all and every method better price information. This rejection is FINAL.

7. Claims 9,18, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reuhl in view of Nymeyer.

The rejection is of record. The applicant again argues that there is no motivation to combine the references. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, price accuracy is a well known variable in the art of Reuhl. One skilled in the art would look to all and every method better price information. This rejection is FINAL.



Richard C Weisberger
Primary Examiner
Art Unit 3624